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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,207	12/12/2003	Krishna Kishore Yellepeddy	AUS920010442US2	1768

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/735,207	YELLEPEDDY ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-16 and 24-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-16 and 24-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Preliminary Amendment received on 12/12/2003 is acknowledged and entered. Claims 1-7, 17-23 and 31-37 have been canceled. Claims 8-16 and 24-30 are currently pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 recites a series of steps which do not include a pre- or post-computer activity but merely perform a series of steps of determining or generating data such as cost of energy generated or purchased, and are directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (establishing or generating data) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335,200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed.

Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). A claim as a whole does not provide any indication about usefulness of the recited method.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-13 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Papalia et al. (US 6,255,805).

Papalia et all (Papalia) teaches a computer-implemented method and computer-readable medium having computer-readable instructions for implementing said method for optimizing energy usage at an end user site comprising:

Independent Claims

Claims 8 and 24,

determining a cost for generating energy at the end user site;

determining the cost of purchasing energy from another energy supplier;

establishing a set of end-user energy policies for generating and using energy at the end-user facility; and

generating a set of energy supply alternatives based on the energy user requirements and the cost of the energy alternatives (C. 2, L. 32 – C. 3, L. 20).

Dependent Claims

Claims 9-12, and 25, same reasoning as applied to claims 8 and 24.

Claims 13 and 27,

generating energy at the end-user facility;

using said generated energy as desired by the end-user; and

selling any excess generated energy to other end-users or to energy suppliers (C. 2, L. 32 – C. 3, L. 20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-16 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neirlich et al. (US 6,519,509).

Dependent Claims

Claims 14-16 and 28-30,

Papalia teaches conducting energy trades in the open market, thereby suggesting placing information about available energy in a location accessible to potential energy purchasers; and negotiating the price and quantity of the energy with a potential energy purchaser. However, Papalia does not explicitly discloses specifics of said trades.

Neirlich et al. (Neirlich) teaches a computer-implemented method and computer-readable medium having computer-readable instructions for implementing said method for optimizing energy usage at an end user site, wherein end-users can activate private energy generators for personal use when buying energy from energy providers is not feasible, and wherein the excess of said energy generated at the end-users premises can be sold to potential energy purchasers, and further wherein various specifics of open market trade are disclosed including placing information about available energy in

a location accessible to potential energy purchasers; negotiating the price and quantity of the energy with a potential energy purchaser; said information containing a desired energy quantity and purchase price; determining whether to accept the offer, reject the offer or to submit a counter offer to the potential purchaser; and submitting a response to the potential energy purchaser, thereby consummating the transaction with the potential energy purchaser (Figs. 12, 13, 19-23; C. 2, L. 51-60; C. 4, L. 23-24; C. 8, L. 25-45; C. 9, L. 23-63; C. 10, L. 43-46; C. 11, L. 21-23; C. 16, L. 35-37).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Papalia to include specifics of conducting energy trades in the open market, as disclosed in Neirlich, because it would advantageously allow to enable monitoring, control, and analysis of load profiles and energy market prices that cover a large number of distributed end-users, as specifically stated in Neirlich (C. 17, L. 5-7).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/21/2006

IGOR N. BORISSOV
PRIMARY EXAMINER